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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 09/662,431   | 09/13/2000  | Newton James Smith JR. | AUS9000386US1       | 9056             |
| 35617  | 7590        | 10/22/2003             | EXAMINER            |                  |
| CONLEY ROSE, P.C.<br>P.O. BOX 684908<br>AUSTIN, TX 78768 |             |                        | PHAM, TUAN          |                  |
|  |             | ART UNIT               |                     | PAPER NUMBER     |
|  |             | 2643                   |                     | 7                |
| DATE MAILED: 10/22/2003                                  |             |                        |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |
|------------------------------|-----------------|--------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |
|                              | 09/662,431      | SMITH ET AL. |
|                              | Examiner        | Art Unit     |
|                              | TUAN A PHAM     | 2643         |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 13 September 2000.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4,6.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Objections***

1. Claim 16 is objected to because of the following informalities: the claim 16 should not be dependent by itself. For examination purposes only, the claim 16 is assumed to be dependent on the claim 15 as show in the Office Action. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beith et al. ("Beith") (U.S. Patent No. 6,321,098) in view of Schuster et al. ("Schuster") (U.S. Patent No. 6,584,490).

Regarding claim 1, Beith teaches an electronic communication device (see figure 1, wireless communication 100) adapted to receive a directory (see col.6, ln.30-35, col.8, ln.54-65).

It should be noticed that Beith fails to clearly teach an electronic notification. However, Schuster teaches such features (see figure 1, PID 110, col.7, ln.5-30) for a purpose of notifying the user whenever they have a message come in.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of electronic notification, as taught by Schuster, into view of Beith in order to automatically store a desired telephone number as received from a directory service.

Regarding claim 2, Schuster further teaches the electronic notification is associated with an identifier, a category heading, and an altered value (see col.7, ln.5-30, col.26, ln.34-67).

Regarding claim 3, Schuster further teaches the electronic communications device wherein the altered value comprises a name, a telephone number, a mailing address or an email address (see col.26, ln.34-67).

Regarding claim 4, Beith further teaches the electronic communications device comprises a telephone (see figure 1, wireless communication device 100, col.2, ln.58-60).

Regarding claim 5, Beith and Schuster, in combination, fails to clearly teach the electronic communication device being a facsimile machine. However, facsimile machine device is well known to include a telephone directory.

Regarding claim 6, Schuster further teaches the electronic communications device wherein the electronic communications device comprises a personal digital assistant (see col.7, ln.16-20).

Regarding claim 7, Beith further teaches the electronic communications device wherein the electronic communications device comprises: a CPU, and a storage medium comprising a data structure wherein the data structure comprises fields adapted for storage of entry content values and an entry identifier associated with each directory entry, and wherein the category heading associated with the electronic notification corresponds to one or more headings of said fields (see figure 1, CPU 100, data storage 126, directory 132, col.1, ln.35-50).

Regarding claim 8, Schuster further teaches the electronic communications device wherein the entry content values comprise a name, a telephone number, a mailing address or an email address (see col.26, ln.34-50).

Regarding claim 9, Beith further teaches the electronic communications device wherein the storage medium comprises a directory management program, wherein the directory management program comprises program instructions executable by the processor for receiving the electronic notification (see figure 1, directory service storage 132, col.3, ln.57-67).

Regarding claim 10, Beith further teaches the electronic communications device wherein the directory management program further comprises program instructions executable by the processor for presenting a permission prompt to the user of the electronic communications device (see figure 1, directory service storage 132, col.3, ln.57-67).

Regarding claim 11, Beith further teaches the electronic communications device wherein the presenting comprises displaying on an output mechanism of the electronic communications device (col.3, ln.9-18).

Regarding claim 12, Beith further teaches the electronic communications device wherein the presenting comprises providing audible output (see col.4, ln.57-60).

Regarding claim 13, Beith further teaches the electronic communications device wherein the directory management program further comprises program instructions executable by the processor for receiving a confirmation indicator to accept the received electronic notification (see figure 1, directory service storage 132, col.3, ln.57-67).

Regarding claim 14, Beith further teaches the electronic communications device wherein the directory management program further comprises program instructions executable by the processor for receiving a reject command to reject the received electronic notification (see figure 1, directory service storage 132, col.3, ln.57-67).

Regarding claim 15, Schuster further teaches the electronic communications device wherein the receiving comprises receiving a vocal input (see col.6, ln.57-59).

Regarding claim 16, Beith further teaches the electronic communications device wherein the receiving comprises receiving a dual tone multi-frequency (DTMF) tone (see col.2, ln.15-18).

Regarding claim 17, Schuster further teaches the electronic communications device wherein the directory management program comprises program instructions executable by the processor for comparing the entry identifier corresponding to the directory entry with the identifier of the electronic notification (see col.7, ln.5-30).

Regarding claim 18, Beith further teaches the electronic communications device wherein the directory management program comprises program instructions executable by the processor for comparing the headings of the fields corresponding to the data structure of the directory with the category heading of the electronic notification upon matching the entry identifier of the directory entry with the identifier of the electronic notification (see col.5, ln.47-58).

Regarding claim 19, Beith further teaches the electronic communications device wherein the directory management program comprises program instructions executable by the processor for replacing one or more entry content values corresponding to the directory entry with the altered value upon matching one or more headings of the fields with the category heading of the electronic notification (see col.5, ln.29-67).

5. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al. ("Cohn") (U.S. Patent No. 6,031,895) in view of Beith et al. ("Beith") (U.S. Patent No. 6,321,098).

Regarding claim 20, Cohn teaches an electronic notification comprising:

receiving the electronic notification indicating that at least a portion of the directory entry has changed to an altered value (see col.10, ln.40-45, col.23, ln.40-59).

It should be noticed that Cohn fails to clearly teach an activating update command. However, Beith teaches such features (see col.1, ln.35-58, col.2, ln.40-49) for a purpose of processing the information entered by user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of an activating update command, as taught by Beith, into view of Cohn in order to automatically activate and update the record of the telephone directory.

Regarding claim 21, Cohn teaches an electronic notification comprising:  
receiving the electronic notification indicating that at least a portion of the directory entry has changed to an altered value (see col.10, ln.40-45, col.23, ln.40-59), and

updating one or more entry content values with the altered value, wherein the entry content values correspond to a field associated with the matching entry identifier and field heading of the directory entry (col.3, ln.1-61).

It should be noticed that Cohn fails to clearly teach a searching entirety of directory entries to match an identifier of the electronic notification with a matching entry identifier associated with the directory entry, and matching a field heading associated with the data structure of the directory entry with a category heading of the electronic notification. However, Beith teaches such features (see col.1, ln.35-57, col.5, ln.30-58) for a purpose of processing the information entered by user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of searching entirety of directory entries to match an identifier of the electronic notification with a matching entry identifier associated with the directory entry, and matching a field heading associated with the data structure of the directory entry with a category heading of the electronic notification, as taught by Beith, into view of Cohn in order to automatically store and update the record of the telephone directory.

Regarding claim 22, Cohn teaches an electronic notification comprising:  
receiving the electronic notification indicating that at least a portion of the directory entry has changed to an altered value (see col.10, ln.40-45, col.23, ln.40-59), and

updating one or more entry content values with the altered value, wherein the entry content values correspond to a field associated with the matching entry identifier and field heading of the directory entry (col.3, ln.1-61).

It should be noticed that Cohn fails to clearly teach a storage medium comprising program instructions executable using a processor within an electronic communications device for searching entirety of directory entries to match an identifier of the electronic notification with a matching entry identifier associated with the directory entry, and matching a field heading associated with the data structure of the directory entry with a category heading of the electronic notification. However, Beith teaches such features (see col.1, ln.35-57, col.5, ln.30-58) for a purpose of processing the information entered by user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of searching entirety of directory entries to match an identifier of the electronic notification with a matching entry identifier associated with the directory entry, and matching a field heading associated with the data structure of the directory entry with a category heading of the electronic notification, as taught by Beith, into view of Cohn in order to automatically store and update the record of the telephone directory.

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Lim et al. (U.S. Patent No. 6,574,599), Creswell et al. (U.S. Patent No. 6,564,264), and Schlachman et al. (U.S. Patent No. 6,504,925) are not applied into this Office Action, they are also called to Applicants attention. They may be used in future Office Action(s). These references are also concerned for supporting the method and apparatus for automatic address updating of outgoing and incoming user messages and automatically update telephone directory information.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (703) 305-4987 and E-mail address: **tuan.pham13@USPTO.GOV**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Curtis Kuntz**, can be reached on (703) 305-4708 and

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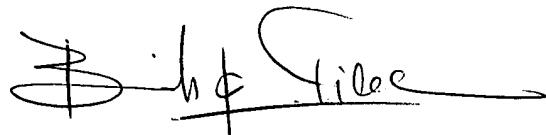
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BINH TIEU  
PRIMARY EXAMINER

Art Unit 2643

Date: October 22, 2003